



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,671	11/21/2003	Sean Collins	047711-0332	1312

7590 03/28/2005

Ted R. Rittmaster
Foley & Lardner
2029 Century Park East
Suite 3500
Los Angeles, CA 90067-3201

EXAMINER

RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
----------	--------------

3677

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,671	Applicant(s) COLLINS ET AL.	
	Examiner Ruth C Rodriguez	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 21,22,24-26,52-54 and 58-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15,23,30-43 and 49-51 is/are rejected.
- 7) ☒ Claim(s) 16-20,27-29,44-48 and 55-57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:I.
Claims 1-57, drawn to a mounting clip, classified in class 24, subclass 3.12.
II. Claims 58-65, drawn to a method of using a mounting clip, classified in class 29, subclass 243.56.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, process can be performed with a materially different mounting clip that has a first end and a second end without the need of a leg portion or a lever.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Claims 1-20, 23, 30-48 and 51 are generic to a plurality of disclosed patentably distinct species comprising:

Species I - Figures 3A-3C, 6A, 6B and 9-11

Species II - Figures 4A, 4B, 7A-7D and 12-16B

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

During a telephone conversation with Irvin C. Harrington on 04 March 2005 a provisional election was made with traverse to prosecute the invention of the mounting clip species II, claims 1-20, 23, 27-51 and 55-57. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21, 22, 24-26, 52-54 and 58-65 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Information Disclosure Statement

3. The information disclosure statement filed 21 November 2003 has been considered for this Office Action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9, 11, 14, 15, 23, 30-37, 39, 42 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Oyamada (US 4,881,150). A clip (20) removably attaches a personal device (22) on a supporting member (48) and comprises a first foot (50), a second foot (52), a leg portion (26) and a lever (28). The first foot frictionally attaches the mounting clip to a first portion of the personal device (Figs. 4-6A). The second foot frictionally attaches the mounting clip to a second portion of the personal device (Figs. 4, 5 and 6C). The leg portion connects the first foot to the second foot (Figs. 4 and 5). The lever is hingedly attached to the leg portion (Figs. 4 and 5). The lever rotates relative to the leg portion for positioning the support member between the lever and leg portion (Figs. 4 and 5).

The first foot and second foot are disposed substantially perpendicular to the leg portion (Figs. 4 and 5).

The second foot comprises a depression for accepting the personal device (Figs. 4, 5 and 6C).

The second foot comprises ridges forming a depression for accepting the personal device (Figs 4, 5 and 6C).

The lever comprises a breakaway point (Figs. 4 and 5).

The first foot, the leg portion and the second foot are integrally formed (Figs. 4 and 5).

The first foot, the leg portion and the second foot are formed in an essentially "C-shaped" configuration (Figs. 4 and 5).

A molding process forms the first foot, the leg portion and the second foot (C. 4, L. 12-13).

The first foot, the leg portion and the second foot are formed from at least one of a thermoplastic, a plastic and a polymer (C. 3, L. 16-19).

The personal device is a personal electronic device (22).

The supporting member is an article of clothing (C. 3, L. 21-24 and Fig. 5).

The supporting member is an undergarment (C. 3, L. 21-24 and Fig. 5).

The first foot includes engagement stop for abutting against corresponding surfaces of the personal device (Figs. 4-6A).

A personal device (22) attaches to a supporting member (48). The personal device comprises a device housing (24) including first engagement elements (34a,38,40) for receiving a mounting clip (20). The mounting clip includes a first foot (50), a second foot (52), a leg portion (26) and a lever (28). The first foot frictionally

attaches the mounting clip to a first portion of the personal device (Figs. 4-6A). The second foot frictionally attaches the mounting clip to a second portion of the personal device (Figs. 4, 5 and 6C). The leg portion connects the first foot to the second foot (Figs. 4 and 5). The lever is hingedly attached to the leg portion (Figs. 4 and 5). The lever rotates relative to the leg portion for positioning the support member between the lever and leg portion (Figs. 4 and 5).

7. Claims 1-9, 11-15, 23, 30-37, and 39-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Shelter et al. (US 4,881,150). A clip (22,24) removably attaches a personal device on a supporting member and comprises a first foot (102), a second foot (104), a leg portion (100) and a lever (30). The first foot frictionally attaches the mounting clip to a first portion of the personal device (Fig. 2). The second foot frictionally attaches the mounting clip to a second portion of the personal device (Fig. 2). The leg portion connects the first foot to the second foot (Figs. 2-14). The lever is hingedly attached to the leg portion (Figs. 2-14). The lever rotates relative to the leg portion for positioning the support member between the lever and leg portion (Fig. 2-14).

The first foot and second foot are disposed substantially perpendicular to the leg portion (Figs. 2-14).

The second foot comprises a depression for accepting the personal device (Figs. 2-14).

The second foot comprises ridges forming a depression for accepting the personal device (Figs. 2-14).

The lever comprises a breakaway point (Figs. 2-14).

The first foot, the leg portion and the second foot are integrally formed (Figs. 2-14).

The first foot, the leg portion and the second foot are formed in an essentially "C-shaped" configuration (Figs. 2-14).

A molding process forms the first foot, the leg portion and the second foot (C. 12, L. 21-26).

The first foot, the leg portion and the second foot are formed from at least one of a thermoplastic, a plastic and a polymer (C. 12, L. 21-26).

The personal device is a personal electronic device (C. 1, L. 6-13).

The personal device is a personal medical device (C. 1, L. 6-13).

The personal device is at least one of an infusion device and medical monitor (C. 1, L. 6-13).

The supporting member is an article of clothing (C. 2, L. 44-46).

The supporting member is an undergarment (C. 2, L. 44-46).

The first foot includes engagement stop for abutting against corresponding surfaces of the personal device (Figs. 2-14).

A personal device attaches to a supporting member (C. 1, L. 6-13 and C. 2, L. 44-46). The personal device comprises a device housing including first engagement elements for receiving a mounting clip (22,24) (Fig. 2). The mounting clip includes a first foot (102), a second foot (104), a leg portion (100) and a lever (30). The first foot frictionally attaches the mounting clip to a first portion of the personal device (Fig. 2).

The second foot frictionally attaches the mounting clip to a second portion of the personal device (Fig. 2). The leg portion connects the first foot to the second foot (Figs. 2-14). The lever is hingedly attached to the leg portion (Figs. 2-14). The lever rotates relative to the leg portion for positioning the support member between the lever and leg portion (Figs. 2-14).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. Claims 10 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyamada. Oyamada discloses that the mounting clip is made of plastic material by a molding process in accordance with claim 9 above. Oyamada fails to disclose that the first foot, the leg portion and the second foot are formed from polycarbonate. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the mounting clip made of polycarbonate since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

Claims 16-20, 27-29, 44-48 and 55-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mooney et al. (US 4,635,836), Budano, II et al. (US 4,741,074), Guzik et al. (US 4,828,153), Oyamada (US 4,881,150), Long et al. (US 5,261,583), Castilla et al. (US 5,528,770), Goldenberg et al. (US 5,697,538), Rankin, Jr. et al. (US 6,032,337), Phillips (US 6,073,318), Lim (US 6,176,401 B1), Kamiya (US 6,311,881 B1), Shelter et al. (US 6,752,299 B2), Rivera et al. (US 2003/0141332 A1) and Japanese Patent Document JP 404187102 A are cited to show state of the art with respect to mounting clips having some of the features being claimed by the current application

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

(Signature)

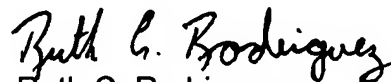
If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP

Art Unit: 3677

§ 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response has been transmitted by facsimile will cause further unnecessary delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

rcr
March 21, 2005